

PATENT

DOCKET NO.: ISIS-4976
Application No.: 10/038,335
Office Action Dated: November 29, 2004

REMARKS

Claims 8-26 are pending in the present application. Claims 8-10 have been allowed. Claims 11-15, 20-22 have been rejected. Claims 16-19 and 23-26 have been objected to. Claims 11-13 have been cancelled without prejudice. No new matter has been added. Upon entry of the present amendment, claims 8-10 and 14-26 will be pending. Reconsideration is respectfully requested in light of these amendments and the following remarks.

I. Rejection under 35 U.S.C. §112

Claims 11-13 are rejected under 35 U.S.C. §112, first paragraph, as allegedly "failing to comply with the enablement requirement." Applicants note that claims 11-13 have been cancelled without prejudice, rendering this rejection moot.

II. Double Patenting

Claims 14-15 and 20-22 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17-21 and 23 of commonly assigned U.S. Patent 5,952,490. Examiner suggests that commonly assigned U.S. Patent 5,952,490 would constitute the basis for rejection under 103(a) of the noted claims if the commonly assigned U.S. Patent 5,952,490 qualifies as prior art under 35 USC 102(e), (f) or (g).

Applicant hereby submits that the subject matter of the claimed invention and the commonly assigned U.S. Patent 5,952,490 were commonly owned at the time the claimed invention was conceived. Applicant has previously submitted a terminal disclaimer in compliance with 37 CFR 1.321(c) and, therefore, respectfully requests the withdrawal of this rejection.

III. Objection to the Claims

Claims 16-19 and 23-26 have been objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 16-19 depend from claim 14 and claims 23-26 depend from claim 21. As discussed in Section II herein, Applicants submit the rejection of the base claim has been overcome by stating that this application and US

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Patent 5,952,490 are commonly owned, were commonly owned at the time the claimed invention was conceived, and the previous filing of a terminal disclaimer. Accordingly, claims 16-19 and 23-26 no longer depend from a rejected based claim. Withdrawal of this objection is, therefore, respectfully requested.

IV. Fees

It is believed that no fee is due with this response. However, if a fee is due, the Commissioner is hereby authorized to charge Deposit Account No. 50-0252 referencing case ISIS-4976.

V. Conclusion

In view of the foregoing, Applicants respectfully submit that the claims are in condition for allowance. An early notice of the same is earnestly solicited. If the Examiner is of a contrary view, the Examiner is requested to contact the undersigned attorney at (760) 603-2767.

Respectfully submitted,


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